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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,879	10/03/2003	John Grunwald	26223-09A	1307

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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/678,879

Applicant(s)

GRUNWALD, JOHN

Examiner

Michael A Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,7-9,11,13,17,20 and 23-33 is/are pending in the application.
- 4a) Of the above claim(s) 25-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,7,9,11,13,17,20,23 and 24 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicants are reminded that the specification and claim 9 defines one of the metal as Wo, which is clearly not intended.

Newly submitted claims 25-33 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The newly added claims define different species of inventions which would have been **restricted** out if originally present. The new claims contain subject matter which would make them distinct species from the original claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25-33 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

NEW REJECTIONS:

Claims 4, 7, 9, 17, 20, 23 and 24 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Small et al. (398).

Small et al. teach in section [0010]-[0029] and the claims, a polishing composition comprising metal oxide grains coated with a metal layer. The metals can include the claimed metals. The abrasive can be combinations of oxides, thus reading on a composite.

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The claimed invention is anticipated by the reference because the reference teaches all of the claimed features defined by the rejected claims above. For example, all metals have a zero valence and since the claimed metals are defined by the reference no distinction is seen to exist. In the alternative, no patentable distinction is seen to exist between the reference and the claimed invention absent evidence to the contrary. Since all metals have a zero valence this aspect is encompassed by the reference. Assuming *arguendo* about the composite, the substitution of one abrasive materials for another is well within the level of ordinary skill in the art. In other words, in view of this disclosure, one skilled in the art would have found it obvious to apply the metal coating on any known abrasive particle.

Claims 11 and 13 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Webb et al.

Webb et al. teach in the abstract and claims 11 and 12, a molded article (i.e. fixed abrasive) which comprises a metal oxide abrasive being coated with a metal layer. The metals can include the claimed metals.

The claimed invention is anticipated by the reference because the reference teaches all of the claimed features defined by the rejected claims above. For example, all metals have a zero valence and since the claimed metals are defined by the reference no distinction is seen to exist. With respect to the pad aspect, applicants are claiming a fixed abrasive and a molded article is clearly a fixed abrasive. *The preamble limitation "polishing pad" is of no consequence when a composition (article) is the same. Ultimate intended utility does not make a composition patentable. See In re Pearson, 181 U.S.P.Q. 641. A fixed abrasive reads*

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on a polishing pad. In the alternative, no patentable distinction is seen to exist between the reference and the claimed invention absent evidence to the contrary. Since all metals have a zero valence this aspect is encompassed by the reference.

Claims 11 and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Andrews et al.

Andrews et al. teaches in sections [0023] and claims 7-9, a molded article (i.e. fixed abrasive) which comprises a metal oxide abrasive being coated with a metal layer. The metals can include the claimed metals.

The claimed invention is anticipated by the reference because the reference teaches all of the claimed features defined by the rejected claims above. For example, all metals have a zero valence and since the claimed metals are defined by the reference no distinction is seen to exist. With respect to the pad aspect, applicants are claiming a fixed abrasive and a molded article is clearly a fixed abrasive. *The preamble limitation "polishing pad" is of no consequence when a composition (article) is the same. Ultimate intended utility does not make a composition patentable. See In re Pearson, 181 U.S.P.Q. 641. A fixed abrasive reads on a polishing pad.* In the alternative, no patentable distinction is seen to exist between the reference and the claimed invention absent evidence to the contrary. Since all metals have a zero valence this aspect is encompassed by the reference.

Claims 11 and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Everett et al.

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Everett et al. teach in the abstract and the claims, a method of applying abrasives to a substrate (i.e. this is a fixed abrasive because the abrasives are fixed onto a substrate), said abrasives comprising a metal oxide abrasive being coated with a metal layer. The metals can include the claimed metals.

The claimed invention is anticipated by the reference because the reference teaches all of the claimed features defined by the rejected claims above. For example, all metals have a zero valence and since the claimed metals are defined by the reference no distinction is seen to exist. With respect to the pad aspect, applicants are claiming a fixed abrasive and a molded article is clearly a fixed abrasive. *The preamble limitation "polishing pad " is of no consequence when a composition (article) is the same. Ultimate intended utility does not make a composition patentable. See In re Pearson, 181 U.S.P.Q. 641. A fixed abrasive reads on a polishing pad.* In the alternative, no patentable distinction is seen to exist between the reference and the claimed invention absent evidence to the contrary. Since all metals have a zero valence this aspect is encompassed by the reference.

Claim 20 is rejected under 35 U.S.C. 103(a) as obvious over Everett et al.

This reference discloses in column 3, lines 28-29, that any suitable abrasive can be coated and since composite abrasive are known abrasive particles, the substitution of one abrasive materials for another is well within the level of ordinary skill ion the art. In other words, in view of this disclosure, one skilled in the art would have found it obvious to apply the metal coating on any known abrasive particle.

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Applicant's arguments with respect to the original claims have been considered but are moot in view of the new ground(s) of rejection.

The previous rejections have been withdrawn because the references do not teach or suggest abrasives having a metal layer thereon.

Assuming *arguendo* about the newly submitted claims 25-26 and 33, they are clearly disclosed by at Small and claim 33 is clearly disclosed by at least one of the other references. Although claim 33 recites the intended use, this does not define a patentable distinction over the art (see case law above). However, new claims 27-32 are still distinct species of inventions because (1) the original claims never claimed any method which comprises using the composition as now claimed. The previous methods were merely methods of using a composition that comprises an abrasive having a metal bearing layer thereon and these methods were nominal methods of using. The new claims, however, use a metal being colloid which forms a coating or a solution that was never defined. **These methods are much more comprehensive than previously claimed and would have been properly restriction out if present before.**

In view of the teachings as set forth above, it is the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

"A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re*

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***LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968)". In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.**

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. Evidence of unexpected results must be commensurate in scope with the subject matter claimed. *In re Linder* 173 USPQ 356.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

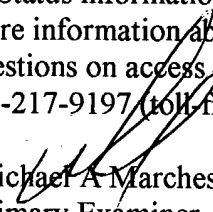
Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record fails to teach or suggest the feature of this claim.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L Bell can be reached on (571) 272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael A Marcheschi
Primary Examiner
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MM
12/04